

REMARKS

Claims 1-25, 37-39 and 41-44 are under consideration with claims 1, 21, 22 and 44 being independent. Claims 27-36 have been withdrawn. Claims 1, 21, and 22 have been amended; claims 26 and 40 have been canceled; and claims 41-44 have been added. No new matter has been added.

Independent claim 22 and its dependent claims (i.e., claims 23-26) have been rejected as claiming non statutory subject matter. The Examiner contends that the “propagated signal” of claim 26 is a non-statutory computer readable medium. To expedite prosecution, applicants have canceled claim 26 and amended claim 22 to recite a “*tangible* computer readable medium” (emphasis added). Accordingly, applicants request reconsideration and withdrawal of this rejection.

Independent claims 1, 21 and 22, and their dependent claims (i.e., claims 2-8, 10-20, 23-25 and 37-39) have been rejected as being anticipated by Morris (WO 00/60809). Applicants have amended claims 1, 21 and 22 to obviate this rejection.

Claims 1, 21 and 22, as amended, each recite “facilitating a text instant message to be sent from the sender to the recipient ... , the text instant message including message text inputted by the sender; enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface *being conditioned on communication of the text instant message between the sender and the recipient*; and enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host” (emphasis added). Applicants request reconsideration and withdrawal of the rejection of claims 1, 21 and 22 because Morris does not describe or suggest the recited first text instant messaging graphical user interface that includes an icon manipulable to invoke voice communications and that is *presented to a recipient conditionally based on whether a text instant message has been communicated between a sender and the recipient*.

Morris describes a system for establishing an audio conference in a networked environment. Morris's system includes an audio communication application have a graphical user interface (GUI) 801 shown in Fig. 8 with which a user may interact to establish a text or

audio conference with another user or users. The GUI 801, which the Examiner seems to equate to the recited first text instant messaging graphical user interface, however, is not presented to the recipient conditionally based on communication of a text instant message between the sender and the recipient. Rather, the GUI 801 is presented to the recipient in response to the recipient manually engaging an icon on the recipient's computer. For example, the GUI 801 may be presented to the recipient in response to the recipient engaging a "FireTalk" audio communication application icon on a client computer. See p. 12, lines 5-9. Once activated manually by the recipient, the GUI 801 is presented to the recipient irrespective of communication of text instant messages or lack thereof between a sender and the recipient. Accordingly, Morris neither describes nor suggests the recited graphical user interface that includes an icon manipulable to invoke voice communications and that is presented to a recipient conditionally *based on whether a text instant message has been communicated between the sender and the recipient.*

For at least this reason, applicants request reconsideration and withdrawal of the rejection of claims 1, 21, and 22, and their dependent claims 2-8, 10-20, 23-25 and 37-39.

Claim 9, which depends from claim 1, has been rejected as being unpatentable over Morris in view of Sekiguchi (U.S. Patent No. 5,848,134). Sekiguchi does not remedy the deficiency of Morris to describe or suggest the recited graphical user interface presented to a recipient conditionally based on whether a text instant message has been communicated between the sender and the recipient. Therefore, for at least the reasons described above, applicants request reconsideration and withdrawal of the rejection of claim 9.

New claims 41-44, including new independent claim 44, have been added. Claim 44 recites "determining, *in response to receipt of the text instant message*, the capabilities of the recipient to accept voice communications; ... enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on whether the recipient is determined to be capable of accepting voice communications" (emphasis added). Neither Morris, Sekiguchi, nor any of the cited art, alone or

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in combination, describes or suggests determining the capabilities of a recipient to accept voice communications in response to receipt of a text instant message from a sender. Accordingly, for at least this reason, claim 44 should be allowed.

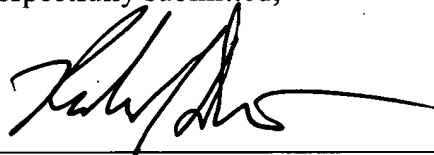
Applicants submit that all claims are in condition for allowance.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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